



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/538,587 | 10/03/2005 | Christoph Hauger | Z50056 | 9032 |

1218 7590 12/21/2007
CASELLA & HESPOS
274 MADISON AVENUE
NEW YORK, NY 10016

EXAMINER

LYONS, MICHAEL A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2877

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

12/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

74

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/538,587 | Applicant(s) HAUGER ET AL. | |
| | Examiner Michael A. Lyons | Art Unit 2877 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 and 26-28 is/are allowed.
- 6) ☒ Claim(s) 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>082707</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Knupfer et al (6,396,587).

Regarding claim 24, Knupfer (Fig. 1) discloses a method wherein scanning of specimen 13 is effected along a one-dimensional line (see element 39) within a lateral scanning plane whose orientation is adjustable. The lenses the light passes through to strike specimen 13 act as a microscope.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knupfer et al (6,396,587).

As for claim 25, Knupfer discloses the claimed invention as set forth above regarding claim 24, but fails to disclose the width of the one-dimensional line. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set the

Art Unit: 2877

one-dimensional line to be the desired resolution and/or the desired signal strength as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

Claims 1-23 and 26-28 are allowed in view of the prior art.

The following is a statement of reasons for the indication of allowable subject matter:

As to claim 1, the prior art of record, taken either alone or in combination, fails to disclose or render obvious a coherence microscope, the microscope comprising, among other essential elements, a point light source emitting measurement light onto a specimen and at least one confocal aperture member, and a microscope optical system that focuses the measurement light on the specimen and focuses the measurement light reflected by the specimen on at least one confocal aperture member, wherein the aperture of the at least one confocal aperture member is so selected that the depth extent of the confocal zone substantially corresponds to the depth stroke of the coherence microscope, in combination with the rest of the limitations of the above claim.

As to claim 28, the prior art of record, taken either alone or in combination, fails to disclose or render obvious a coherence microscope, the microscope comprising, among other essential elements, an optical fiber which feeds measurement light from a point light source to a microscope optical system and an ordered fiber bundle which is interposed between the optical fiber and the microscope optical system, the fibers of the ordered fiber bundle being arranged in linearly mutually juxtaposed relationship at the proximal end thereof; and a scanning device

Art Unit: 2877

including a rotatable polygonal mirror for coupling measurement light into the fibers of the ordered fiber bundle and/or for coupling measurement light reflected by the specimen out of the fibers, in combination with the rest of the limitations of the above claim.

For further reasoning regarding the above, please see the applicants' arguments dated September 18, 2007 in response to the previous Office action of record.

Response to Arguments

Applicants' arguments filed September 18, 2007 have been fully considered but they are not persuasive as regarding claims 24-25.

On page 17 of the applicants' response, applicants state; "Amended claim 24 is directed to a method using a coherence microscope as defined in amended claim 1. For at least the reasons set forth above in relation to claim 1, claim 24 is patentably distinct and not rendered obvious by any combination of the references of record, and therefore, is in condition for allowance with dependent claim 25". The examiner respectfully disagrees.

Claim 24, although it recites the entirety of allowable claim 1, is directed to a method of operating a coherence microscope. The limitations of claim 1 are merely part of the preamble of the claim. Because the body of the claim fails to draw upon the limitations of the preamble, the limitations contained in the preamble carry no patentable distinction when determining the patentability of the claim. (See *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951) and MPEP 2111.02). Accordingly, claim 24 sets forth a method of operating a coherence microscope where scanning of the specimen is effected along a one-dimensional line within a lateral scanning plane whose orientation is adjustable. Since a coherence microscope other than the one set forth in

Art Unit: 2877

both claim 1 and the preamble of claim 24 can perform this method, such as the microscope disclosed above in the rejection of claim 24, the claim stands as rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

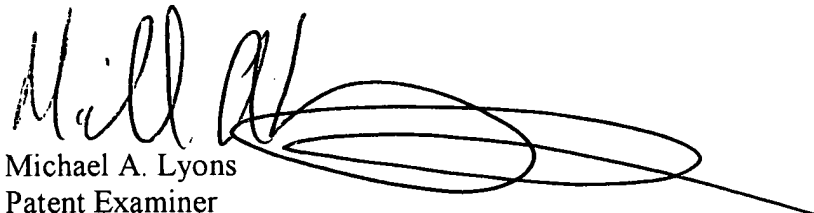
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Lyons whose telephone number is 571-272-2420. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley can be reached on 571-272-2800 ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2877

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael A. Lyons
Patent Examiner
December 18, 2007